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10/830,064	04/23/2004	Tetsuro Motoyama	252122US-2 CONT	8744

  

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EXAMINER	
DAILEY, THOMAS J	

  

ART UNIT	PAPER NUMBER
2452	

  

NOTIFICATION DATE	DELIVERY MODE
12/23/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/830,064	<b>Applicant(s)</b> MOTOYAMA ET AL.	
	<b>Examiner</b> Thomas J. Dailey	<b>Art Unit</b> 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/12/2008; 7/23/2004</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

**+DETAILED ACTION**

1. Claims 31-47 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2008 has been entered.

***Response to Arguments***

3. Applicant's arguments filed October 17, 2003 have been fully considered but they are not persuasive.
4. The applicant argues with respect to claim 31 that the combination of Cheng et al (US Pat. 6,151,643), in view of Elg (US Pat. 6,694,354), fails to disclose requesting, from an office device by the first version of the device driver installed on the computer, version information of the newest version of the device driver that is stored in the memory of the office device. Specifically contending Cheng is silent regarding a device driver installed on a computer requesting information of a newest version of the device driver stored in memory of the office device.

5. The examiner disagrees. Cheng discloses requesting, from an office device by the first version of the device driver installed on the computer, version information of the newest version of the device driver that is stored in the memory of the office device (column 7, lines 46-62, client application gathers version information from software (software includes drivers), on client computer (the computer), and requests information regarding the latest versions that are available from the service provider (office device)). While the request to the service provider is not directly from the device drivers, the drivers are still essentially making the request via the client application, i.e. the drivers provide version information to the application and that information is relayed to the service provider. That is to say, without the device drivers installed on the client computer, there would not be requests to update that driver.
6. The applicant further argues Cheng fails to disclose receiving, from an office device to which the computer is communicatively coupled the version information of the newest version of the device driver that is stored in the memory of the office device, wherein both the first version and the newest version of the device driver are configured to control operations of the office device, and Elg fails to disclose requesting, from an office device by the first version of the device driver installed on the computer, version information of a newest version of the device driver that is stored in a memory of the office device.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 31-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al (US Pat. 6,151,643), hereafter "Cheng," in view of Elg (US Pat. 6,694,354).
10. As to claim 31, Cheng discloses a method of updating a first version of a device driver installed on a computer of a user the method comprising:
- requesting, from an office device by the first version of the device driver installed on the computer, version information of the newest version of the device driver that is stored in the memory of the office device (column 7, lines 46-62,

client application gathers version information from software (software includes drivers), on client computer (the computer), and requests information regarding the latest versions that are available from the service provider (office device); while the request to the service provider is not directly from the device drivers, the drivers are still essentially making the request via the client application, i.e. the drivers provide version information to the application and that information is relayed to the service provider),

receiving, from the office device to which the computer is communicatively coupled, version information of the newest version of the device driver that is stored in the memory of the office device (column 3, lines 25-39, user computer receives from service provider computer system (office device) information regarding available updates);

determining, based on the received version information, whether the first version of the device driver installed on the computer is different from the newest version of the device driver stored in said memory (column 3, lines 32-39);

if the determining step determines that the first version is different from the newest version, inquiring whether the user wants to update the device driver on the computer with the newest version of the device driver (column 3, lines 38-42, user identifies updates to be made; column 5, lines 28-33 also indicates a method of user approval before the software update); and

if the inquiring step determines that the user wants to update the device driver, obtaining the newest version of the device driver from the office device (column 3, lines 41-45).

But, Cheng does not explicitly disclose wherein both the first version and the newest version of the device driver are configured to control operations of the office device.

However, Elg discloses receiving, from an office device to which a computer is communicatively coupled, version information of a newest device driver that is stored in a memory of the office device, wherein the device driver is configured to control operations of the office device (column 5, lines 16-27, peripheral device reads on office device, i.e. the peripheral device stores its own device drivers and related information, and the device drivers are installed on the host computer if necessary).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Cheng and Elg in order to allow a peripheral device to connect to a host computer and not require the host computer to externally search for appropriate drivers.

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11. As to claims 36, 41 and 46, they are rejected by the same rationale set forth in claim 31's rejection.

12. As to claims 32, 37, and 42, Cheng discloses:

displaying, on a display associated with the computer, a message regarding whether the user wants to update the device driver (column 5, lines 24-32, display device is inherent as the user must read the email in regards to an available update, and the approval of the update); and

receiving a response from the user, said response indicating whether the user wants to update the device driver with the newest version (column 5, lines 30-32).

13. As to claims 33, 38, and 43, Cheng discloses:

establishing a connection to the office device (column 3, lines 41-45);

receiving, from the office device, an installation file for the newest version of the device driver (column 3, lines 41-45 and column 10, lines 33-54, the URL is the installation file for the newest version of the device driver); and

storing said installation file in a temporary storage area associated with the computer (column 10, lines 33-54, client computer retrieve URL and must store it in order to access).



14. As to claims 34, 39, and 44, Cheng discloses executing the stored installation file to install the newest version of the device driver on the computer (column 10, lines 33-54, installation of software update via execution of URL).

15. As to claims 35, 40, and 45, Cheng discloses generating commands and associated data for controlling said office device, prior to said receiving step (column 3, lines 25-29).

16. As to claim 47, Elg discloses the office device is a printer and the device driver is configured to control operations of the printer (column 2, lines 60-65).

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./  
Examiner, Art Unit 2452

/Kenny S Lin/  
Primary Examiner, Art Unit 2452